

REMARKS

This is intended as a full and complete response to the Office Action dated April 27, 2005, having a shortened statutory period for response extended one month set to expire on August 27, 2005. Claims 1-84 remain pending in the application. Please reconsider the claims pending in the application for reasons discussed below.

Election/Restrictions

The Examiner indicated that claims 28-42, 62, 79, and 83 are withdrawn from further consideration pursuant to 37 C.F.R. § 1,142(b).

Specification

The Examiner objected to the specification due to the language and the format of the abstract. In response, Applicants have amended the abstract accordingly. Applicants respectfully request the objection be removed.

Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a). In response, Applicants have amended the claims accordingly.

Claim Objections

The Examiner objected to claim 45 under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. In response, Applicants have cancelled claim 45. Applicants respectfully request the objection to the claims be removed.

Claim Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 61, 63, 82, and 84 under 35 U.S.C. § 102(b) as being anticipated by *Campbell* '745. In response, Applicants have amended claims 1, 61, 63, 82, and 84.

As amended, claim 1 includes the limitation of a restraining member for restraining part of the other expandable tubing section upon expansion of the section,

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the restraining member extending from a distal end of the second tubular and including an area of reduced thickness permitting flexible movement of the restraining member about the area of reduced thickness. *Campbell* does not disclose a restraining member extending from a distal end of a tubular defining a female portion and including an area of reduced thickness permitting flexible movement of the restraining member about the area of reduced thickness upon expansion of the section.

As amended, claims 61 and 82 include the limitation of a second expandable tubing section including a bore with a countersunk portion, the bore extending through the threaded female portion. *Campbell* does not disclose a countersunk bore on an expandable tubing defining a female portion.

As amended, claims 63 and 84 include the limitation of a first expandable tubing section and a second expandable tubing section wherein more than half of the length between the respective first and second shoulders is threaded to minimize separation of the first expandable tubular from the second expandable tubular upon expansion of the connection arrangement. *Campbell* does not disclose this limitation.

Campbell therefore fails to teach each and every one of the limitations of amended claims 1, 61, 63, 82, and 84, and this failure precludes *Campbell* from anticipating claims 1, 61, 63, 82, and 84. For reasons set forth above, Applicants submit that claims 1, 61, 63, 82, and 84 are in condition for allowance and respectfully request withdrawal of the § 102(b) rejection of claims 1, 61, 63, 82, and 84. Additionally, 2-6, 9-15, 64-65, and 71-75 depend from the amended claims, and these claims are allowable for at least the same reasons.

The Examiner rejected claims 43, 56, 76, 80, and 81 under 35 U.S.C. § 102(a) as being anticipated by *Coulon, et al.* In response, Applicants have amended claims 43, 56, 76, 80, and 81.

As amended, claims 43 and 80 include a similar limitation of a second expandable tubing section including a non threaded restraining member extending from an distal end thereof for restraining part of a first expandable tubing section, the restraining member including a hinge about which the restraining member is adapted to bend upon expansion of a portion of the first expandable tubing section. *Coulon, et al.*

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does not disclose a non-threaded restraining member extending from a distal end of a tubular defining a female portion and including a hinge about which the restraining member is adapted to bend upon expansion of a portion of the first expandable tubing section.

As amended, claims 56 and 81 include a similar limitation of a first expandable tubing section having a threaded male portion, a lip portion and an end face and a second expandable tubing section having a threaded female portion, a lip portion and an end face, the first and second expandable tubing sections being engageable with one another to form a threaded connection wherein a cross-sectional thickness of the first expandable tubing section is greater in the region of the male threaded portion than at a point axially spaced from the male threaded portion, wherein the expansion of the tubing sections the bending substantially occurs axially on either side of the engaged threaded portions rather than across the threaded connection. *Coulon, et al.* does not disclose this limitation.

As amended, claim 76 includes the limitation of providing a restraining member that extends from a distal end of a second expandable tubing section defining a female portion, the restraining member having an area of reduced thickness and expanding a portion of the first tubular thereby permitting the restraining member to flex around the area of reduced thickness. *Coulon, et al.* does not disclose a restraining member extending from a distal end of a tubular defining a female portion and including an area of reduced thickness about which the restraining member is adapted to bend on expansion.

As amended, claim 78 includes the limitation of providing a second expandable tubing section defining a threaded female portion having lead and back thread flanks, the back thread flanks of the threaded male and female portions being disposed at an acute angle with respect to respective main thread axes such that the respective thread portions are angled away from an adjacent end of the respective tubing section, wherein the acute angle is between 40 and 90 degrees. *Coulon, et al.* does not disclose this limitation.

Coulon, et al. therefore fails to teach each and every one of the limitations of amended claims 43, 56, 76, 80, and 81, and this failure precludes *Coulon, et al.* from

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anticipating claims 43, 56, 76, 80, and 81. For reasons set forth above, Applicants submit that claims 43, 56, 76, 80, and 81 are in condition for allowance and respectfully request withdrawal of the § 102(a) rejection of claims 43, 56, 76, 80, and 81. Additionally, 47-51, 55, 57-60, and 78-79 depend from the amended claims, and these claims are allowable for at least the same reasons.

The Examiner rejected claim 43 under 35 U.S.C. § 102(e) as being anticipated by *Metcalfe*. In response, Applicants have amended claim 43.

As amended, claim 43 includes the limitation of a second expandable tubing section including a non threaded restraining member extending from an distal end thereof for restraining part of a first expandable tubing section, the restraining member including a hinge about which the restraining member is adapted to bend upon expansion of a portion of the first expandable tubing section. *Metcalfe* does not disclose a non-threaded restraining member extending from a distal end of a tubular defining a female portion and including a hinge about which the restraining member is adapted to bend upon expansion of a portion of the first expandable tubing section.

Metcalfe therefore fails to teach each and every one of the limitations of amended claim 43, and this failure precludes *Metcalfe* from anticipating claim 43. For this reason, Applicants submit that claim 43 is in condition for allowance and respectfully request withdrawal of the § 102(e) rejection of claim 43. Additionally, 46-48 and 51-53 depend from the amended claim 43, and these claims are allowable for at least the same reasons as claim 43.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 16-27 and 77 as being unpatentable over *Coulon, et al.* According to the Examiner, it would have been obvious to a person having ordinary skill in the art to make the threads at various angles because a change in the shape of a prior art device is a design consideration within in the skill of the art. Applicants respectfully traverse the rejection.

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MPEP 2143.03 provides:

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)."

Further, MPEP 2144.04(B) provides:

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

Finally, MPEP 2144.04(C) provides:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

As set forth above, the Examiner cannot merely state that it would have been obvious to make the threads at various angles with no evidence as to why it would be

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obvious to do so. A general rationale that "a change in the shape of a prior art device is a design consideration" without some teaching in the prior art is a rationale based on impermissible hindsight and is not permitted within the confines of 35 U.S.C. § 103.

For the reasons set forth above, the Examiner has failed to make a *prima facie* showing of obviousness and, therefore, claims 16-27 and 77 are patentable over *Coulon, et al.* Thus, Applicants respectfully submit that claims 16-27 and 77 are in condition for allowance and request withdrawal of the § 103(a) rejection.

The Examiner rejected claim 66 as being unpatentable over *Campbell*. Applicants have cancelled claim 66, thereby obviating the rejection

The Examiner rejected claims 67-70 as being unpatentable over *Campbell* in view of PCT WO 00/0831. Applicants respectfully traverse. Claims 67-70 depend from amended claim 1. As set forth above, *Campbell* fails to teach or suggest all the limitations in amended claim 1. Similarly, PCT WO 00/0831 fails to teach or suggest all the limitations of amended claim 1. For this reason, neither *Campbell* and/or PCT WO 00/0831 can be used to render claims 67-70 obvious. Applicants therefore submit that claims 67-70 are in condition for allowance and respectfully request withdrawal of the § 103(a) rejection.

Conclusion

In conclusion, the references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

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Respectfully submitted,



William B. Patterson
Registration No. 34,102
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants

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